

***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES***

Applicant: Roy J. Mankovitz  
Title: APPARATUS AND METHODS FOR  
ACCESSING INFORMATION RELATING  
TO RADIO AND TELEVISION PROGRAMS  
Appl. No.: 09/292,275  
Filing Date: 4/15/1999  
Examiner: Dominic D. Saltarelli  
Art Unit: 2623  
Confirmation Number: 3332

**BRIEF ON APPEAL**

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Sir/Madam:

This Appeal Brief is being filed in response to the Final Office Action mailed April 17, 2008, rejecting Claims 78-82, 92-110, 117-130, 132-137, 160 and 161, and the Advisory Action mailed June 27, 2008. A Notice of Appeal was filed on July 17, 2008. As such, this Appeal Brief under the provisions of 37 C.F.R. § 41.37 is timely filed. This Appeal Brief is being filed together with a credit card payment form in the amount of \$510.00 covering the 37 C.F.R. 41.20(b)(2) appeal fee. If this fee is deemed to be insufficient, authorization is hereby given to charge any deficiency (or credit any balance) to the undersigned deposit account 19-0741.

Appellant respectfully requests reconsideration of the Application.

**REAL PARTY IN INTEREST**

The real party in interest is Bismuth Landless Wire L.L.C., the assignee of record, having a place of business at 2215-B Renaissance Drive, Suite 5, Las Vegas, Nevada 89119, USA. The assignment from the inventor Roy J. Mankovitz to Patent Lab, L.L.C. was recorded in the records of the United States Patent and Trademark Office at Reel/Frame 015442/0051 on December 9, 2004. The assignment was directed to parent application number 08/849,354 filed November 22, 1995 and all continuing applications thereof. The assignment from Patent Lab, L.L.C. to Bismuth Landless Wire L.L.C. was recorded in the records of the United States Patent and Trademark Office at Reel/Frame 015711/0743 on March 2, 2005.

**RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences that will directly affect, be directly affected by, or have a bearing on the present appeal, that are known to Appellant or Appellant's patent representative.

**STATUS OF CLAIMS**

Claims 1-77, 83-91, 111-116, 131, 138-159, and 162-165 have been cancelled. The present appeal is directed to Claims 78-82, 92-110, 117-130, 132-137, 160, and 161, all of which stand rejected pursuant to a Final Office Action dated April 17, 2008, and an Advisory Action dated June 27, 2008. Claims 78-82, 92-110, 117-130, 132-137, 160, and 161 are being appealed. Claims 1-165 with the appropriate status reference are shown in the attached Claims Appendix.

**STATUS OF AMENDMENTS**

The present application was filed on April 15, 1999 with claims 1-58.

Included in the application filed on April 15, 1999 was a first preliminary amendment that cancelled claims 1-58 and added claim 59. A second preliminary amendment was filed on June 18, 1999 that added claims 60-61. A third preliminary amendment was filed on October 11, 1999 that added claims 62-77. A fourth preliminary amendment was filed on April 21, 2000 that added claims 78-82. A fifth preliminary amendment was filed on September 21, 2000 that added claims 83-91. A sixth preliminary amendment was filed on December 6, 2000 that added claims 92-165.

A Non-Final Office Action with a Restriction Requirement was mailed on April 13, 2004. In the Restriction Requirement, the Examiner asserted that Claims 59-61, Claims 62-77, 83-91, 111-116, and 138-143, Claims 78-82, 92-110, 117-137, 160, and 161, and Claims 144-159, and 162-165 correspond to four distinct inventions. In a response to the Restriction Requirement filed on July 12, 2004, Appellant elected claims 78-82, 92-110, 117-137, 160, and 161.

A Non-Final Office Action was mailed on March 22, 2007. In a supplemental response filed on July 31, 2007, Claims 92, 95-96, 98-101, 103-104, 106-107, 110, 117, 123, 126, 128-130, 134-135, 137, and 160-161 were amended to correct typographical errors and to provide a proper antecedent basis where necessary. A Non-Final Office Action was mailed on October 17, 2007. In a response filed February 19, 2008, Claims 78-82, 92-110, 117-130, 132-137, 160, and 161 were amended, and Claim 131 was canceled.

A Final Office Action was mailed on April 17, 2008. In an after final response filed on June 13, 2008, Claims 78, 92, and 117 were amended. As a result, Claims, 78-82, 92-110, 117-130, 132-137, 160, and 161 were pending in the Application when an Advisory Action dated June 27, 2008, was issued by the Examiner. In the Advisory Action dated June 27, 2008, the amendments to Claims 78, 92, and 117 were considered and entered by the

examiner. No amendments have been made in the present Application subsequent to receipt of the Advisory Action dated June 27, 2008. As such, it is submitted that Claims 78-82, 92-110, 117-130, 132-137, 160, and 161 are now pending in this application.

### **SUMMARY OF CLAIMED SUBJECT MATTER**

Three independent claims, Claims 78, 92, and 117, are under appeal. In addition, dependent Claims 94, 95, 103, 104, 107, 109, 134, 136, and 161 are separately argued. There are no means plus function or steps plus function claims pending in the present application.

Support for Claim 78 can be found at least as follows: Claim 78 is directed toward a “method of providing supplemental information about a broadcast.” (See, for example, one embodiment on page 8, lines 35-36). Claim 78 recites “a portable, hand-held electronic device.” (See, for example, embodiments on page 11, lines 10-11 and in Fig. 3). Claim 78 also recites “receiving, at a portable, hand-held electronic device, a request for supplemental information associated with the broadcast.” (See, for example, one embodiment on page 15, lines 12-17). Claim 78 also recites “wherein the hand-held electronic device includes a memory [(see, for example, one embodiment on page 8, line 37)], a communications interface [(see, for example, embodiments on page 8, lines 37-38, page 9, lines 27-31, and page 13, lines 11-19)], and a clock.” (See, for example, one embodiment on page 8, line 37). Claim 78 also recites “storing, in the memory, time-of-day information corresponding to a time at which the request is received.” (See, for example, one embodiment on page 9, lines 1-3). Claim 78 also recites “wherein the time-of-day information is provided by the clock.” (See, for example, one embodiment on page 10, lines 4-7). Claim 78 further recites “establishing a connection to a remote database through the communications interface.” (See, for example, one embodiment on page 15, lines 36-38). Claim 78 further recites “transferring the time-of-day information stored in the memory to the

remote database.” (See, for example, one embodiment on page 16, lines 1-2 and 14-15). Claim 78 further recites “receiving the supplemental information, associated with the broadcast and identified through correlation of the time of day information to the broadcast, from the remote database.” (See, for example, one embodiment on page 16, lines 11-16). Claim 78 further recites “communicating the supplemental information using the hand-held electronic device.” (See, for example, one embodiment on page 15, lines 22-25).

Support for Claim 92 can be found at least as follows: Claim 92 is directed toward a “system for providing supplemental information about a broadcast.” (See, for example, one embodiment on page 8, lines 35-36). Claim 92 recites “a device located remotely.” (See, for example, one embodiment on page 11, lines 10-11). Claim 92 also recites “a database for storing supplemental information about a broadcast as a function of a time of day.” (See, for example, one embodiment on page 9, lines 21-24). Claim 92 also recites “the device including a memory [(see, for example, one embodiment on page 8, line 37)], a communications interface [(see, for example, one embodiment on page 8, lines 37-38; page 9, lines 27-31; page 13, lines 11-19)], a clock [(see, for example, one embodiment on page 8, line 37)], and a controller.” (see, for example, one embodiment on page 21, lines 20-22). Claim 92 also recites “store time-of-day information from the clock in the memory.” (See, for example, one embodiment on page 9, lines 1-3). Claim 92 also recites “wherein the time-of-day information corresponds to a time at which a request for the supplemental information is received.” (See, for example, one embodiment on page 9, lines 1-3). Claim 92 further recites “establish a connection to the database through the communications interface.” (See, for example, one embodiment on page 15, lines 36-38). Claim 92 further recites “communicate the time-of-day information stored in the memory to the database.” (See, for example, one embodiment on page 16, lines 1-2 and 14-15). Claim 92 further recites “for identification of the supplemental information associated with the broadcast.” (See, for example, one embodiment on page 16, lines 11, 16). Claim 92 further recites “for

communication of the supplemental information to the device.” (See, for example, one embodiment on page 15, lines 22-25).

Support for Claim 117 can be found at least as follows: Claim 117 is directed toward a “device for providing supplemental information associated with a broadcast.” (See, for example, one embodiment on page 8, lines 35-36). Claim 117 recites “a control [(see, for example, one embodiment on page 9, lines 1-4)], a memory [(see, for example, one embodiment on page 8, line 37)], a communications interface [(see, for example, embodiments on page 8, lines 37-38, page 9, lines 27-32, and page 13, lines 11-19)], a clock [(see, for example, one embodiment on page 8, line 37)], and a controller.” (See, for example, one embodiment on page 21, lines 20-22). Claim 117 also recites “wherein the controller is configured to: store time-of-day information from the clock in the memory.” (See, for example, one embodiment on page 9, lines 1-3). Claim 117 also recites “wherein the time-of-day information corresponds to a time at which a request for the supplemental information is received through the control.” (See, for example, one embodiment on page 9, lines 1-3). Claim 117 also recites “establish a connection to a database through the communications interface.” (See, for example, one embodiment on page 15, lines 36-38). Claim 117 also recites “wherein the database includes the supplemental information.” (See, for example, embodiments on page 9, lines 21-24 and on page 10, lines 14-30). Claim 117 further recites “communicate the time-of-day information stored in the memory to the database.” (See, for example, one embodiment on page 16, lines 1-2 and 14-15). Claim 117 further recites “for identification of the supplemental information associated with the broadcast.” (See, for example, one embodiment on page 16, lines 11-16).

Support for dependent Claim 94 can be found at least as follows: Claim 94 recites that “supplemental information is stored as a function of station identification information,” (see, for example, one embodiment on page 4, lines 1-10) that “the device further includes a broadcast station tuner for deriving the station identification information,” (see, for

example, one embodiment on page 13, lines 3-8) and that “the station identification information is communicated to the database along with the time-of-day information to identify the supplemental information to be communicated to the device.” (See, for example, embodiments on page 24, line 33 – page 25, line 37, and on page 26, lines 7-11).

Support for dependent Claim 95 can be found at least as follows: Claim 95 recites “wherein the memory is removable from the device (see, for example, one embodiment on page 9, lines 13-15) for transport to a different location for communicating the time-of-day information to the database.” (See, for example, embodiments on page 10, lines 7-10 and on page 18, lines 35-38).

Support for dependent Claim 103 can be found at least as follows: Claim 103 recites “wherein the controller is configured to ... store identification information in the memory” (see, for example, one embodiment on page 18, lines 33-34) and “communicate the identification information to the database along with the request.” (See, for example, embodiments on page 10, lines 7-9 and on page 11, lines 7-9).

Support for dependent Claim 104 can be found at least as follows: Claim 104 recites “further including data processor means for analyzing the identification information to determine a number of requests for the supplemental information.” (See, for example, one embodiment on page 38, lines 8-28).

Support for dependent Claim 107 can be found at least as follows: Claim 107 recites “data processor means for erasing the time-of-day information from the memory in response to a request from the database.” (See, for example, one embodiment on page 57, lines 3-5).

Support for dependent Claim 109 can be found at least as follows: Claim 109 recites “wherein the supplemental information includes a copy of the broadcast in an audio format, a video format, or a text format. (See, for example, one embodiment on page 21, lines 4-5).

Support for dependent Claim 134 can be found at least as follows: Claim 134 recites “wherein the controller is further configured to erase the time-of-day information from the memory in response to a request from the database.” (See, for example, one embodiment on page 57, lines 3-5).

Support for dependent Claim 136 can be found at least as follows: Claim 136 recites “wherein the supplemental information includes a copy of the broadcast.” (See, for example, one embodiment on page 21, lines 4-5).

Support for Claim 161 can be found at least as follows: Claim 161 recites “wherein the database is configured to analyze the identification information to determine a number of requests for the supplemental information.” (See, for example, one embodiment on page 38, lines 8-28).

#### **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Three grounds of rejection are presented for review in this appeal. Claims 78-82, 92, 93, 95, 96, 102-104, 106-110, 117-122, 124-130, 133-137, 160, and 161 were rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 5,438,355 to Palmer (hereinafter “Palmer”) in view of United States Patent No. 5,382,970 to Kiefl (hereinafter “Kiefl”) and further in view of United States Patent No. 5,410,326 to Goldstein (hereinafter “Goldstein”). Claims 94, 105, 123, and 132 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Palmer, Kiefl, and Goldstein, and further in view of United States Patent No. 4,955,070 to Welsh et al. (hereinafter “Welsh”). Claims 97-101 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Palmer, Kiefl, and Goldstein, and further in view of United States Patent No. 5,583,763 to Atcheson et al. (hereinafter “Atcheson”).



**ARGUMENT**

**I. LEGAL STANDARD UNDER 35 U.S.C. § 103(a)**

35 U.S.C. 103(a) states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The legal standards under 35 U.S.C. 103(a) are well-settled. Obviousness under 35 U.S.C. 103(a) involves four factual inquiries: (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of nonobviousness. *See Graham v. John Deere Co.*, 383 U.S. 1 (1966).

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Piasecki*, 745 F.2d 1468, 1471-72 (Fed. Cir. 1984).

According to M.P.E.P. § 706.02(j),

35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation >as to< why >the claimed invention would have been obvious to< one of ordinary skill in the art at the time the invention was made\*\*.

\*\* "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

## **II. REJECTIONS OF CLAIMS 78-82, 92, 93, 95, 96, 102-104, 106-110, 117-122, 124-130, 133-137, 160, 161 UNDER 35 U. S. C. § 103(a)**

In section 3 of the Final Office Action, Claims 78-82, 92, 93, 95, 96, 102-104, 106-110, 117-122, 124-131, 133-137, 160, and 161 were rejected under 35 U. S. C. § 103(a) as being unpatentable over Palmer in view of Kiefl and further in view of Goldstein. For the reasons given below, Appellant submits that the Examiner's rejection of Claims 78-82, 92, 93, 95, 96, 102-104, 106-110, 117-122, 124-130, 133-137, 160, and 161 is improper and should be reversed.

- (i) The combination of Palmer, Kiefl, and Goldstein fails to teach, describe or suggest time-of-day information

Claim 78 recites "storing, in the memory, time-of-day information corresponding to a time at which the request is received, wherein the time-of-day information is provided by the clock." (Emphasis added). Claims 92 and 117 each recite "a controller" configured to "store time-of-day information from the clock in the memory, wherein the time-of-day information corresponds to a time at which a request for the supplemental information is received" through the user control. (Emphasis added). By contrast, Palmer, Kiefl, and Goldstein fail to teach, suggest, or describe at least these elements.

As acknowledged by the Examiner on page 5 of the Final Office Action mailed April 17, 2008, Palmer fails to disclose a clock outputting time-of-day information. It follows that Palmer also fails to disclose "storing ... time-of-day information corresponding to

a time at which the request is received,” as recited in Claim 78, or a controller configured to store “time-of-day information [which] corresponds to a time at which a request for the supplemental information is received,” as recited in Claims 92 and 117.

However, the Examiner has relied upon col. 6, lines 38-51 of Kiefl, and asserts that Kiefl teaches such elements. Appellant respectfully disagrees with the Examiner’s interpretation. The cited portion of Kiefl states that:

The channel detector in interface 22 provides a signal to microprocessor 23 representing the channel of record and microprocessor 23 stores the information in a location in a memory 28, together with data on the *beginning time and end time at which the channel was selected by remote control 10* (FIG. 1) or, initially, by manual input to the personal data meter 16 if, for example, the television is already operating when the viewer enters the room. However, to avoid recording times for each channel selected when a viewer is scanning through a number of channels, *it is desirable not to provide a record of channels selected for less than a preset short time, say for example, five seconds or less. With this exception, the data is stored in memory 28.*

(Emphasis added.) From the above passage, it is clear that Kiefl teaches storing a beginning time and end time at which the channel was selected by remote control while excluding channels selected for less than a preset short time. Thus, Kiefl discloses storing time windows defined by a beginning time and an end time. Such time windows cannot be short, for example, less than five seconds. If the time windows are less than five seconds, they are not stored. Contrary to the Examiner’s assertions, Appellant respectfully submits that the time windows disclosed in Kiefl are clearly different from “time-of-day information **corresponding to a time at which the request is received**,” as claimed.

(Emphasis added.) Further, the time windows disclosed in Kiefl teach away from the claimed invention and would make the claimed invention inoperable. For example, it may take less than five seconds to make a request, and for the time-of-day information corresponding to a time at which the request is received to be stored. Employing the system of Kiefl in an attempt to arrive at the claimed invention would cause many of the

“requests,” and subsequently the “supplemental information,” to be lost because the time windows of Kiefl are in excess of five seconds.

For at least these reasons, Appellant respectfully submits that Palmer, Kiefl, and Goldstein do not teach each of the elements recited in Claims 78, 92, and 117. For at least these reasons, Appellant respectfully submits that the rejection of Claims 78, 92, and 117 under 35 U. S. C. § 103(a) is improper and should be reversed. For at least the same reasons, Appellant also submits that the rejection of Claims 79-82, which depend from Claim 78, Claims 93, 95, 96, 102-104, and 106-110, which depend from Claim 92, and Claims 118-122, 124-130, 133-137, 160, and 161, which depend from Claim 117, are also improper and should be reversed.

- (ii) The combination of Palmer, Kiefl, and Goldstein fails to disclose supplemental information about a broadcast as claimed

Claims 78, 92, and 117 reach “supplemental information.” On page 6 of the Final Office Action, the Examiner acknowledged that Palmer and Kiefl fail to disclose the “supplemental information” as claimed. However, on page 7 of the Final Office Action, the Examiner has relied upon Fig. 6A of Goldstein, and asserts that Goldstein teaches the claimed “supplemental information about a broadcast.” Appellant respectfully disagrees with the Examiner’s interpretation.

Goldstein is directed toward “a universal programmable remote control device which may be used by a consumer for controlling a variety of consumer products.” (Col. 3, lines 14-17). Goldstein discloses that the remote control includes “various input ports 26, 27 and 28” such that “embedded data in a television broadcast” is transferred “to the remote control device.” (Col. 7, line 67 – col. 8, line 1). The remote control includes “a real time clock 16.” (Col. 7, lines 37-38). Fig. 6A of Goldstein merely shows advertisement information for a future show. Col. 11, lines 15-26 of Goldstein clarifies what the content of the displayed information is directed toward:

A touch screen associated with the remote control device has additional features to be implemented. For instance, the full display screen can be used to display advertisements, such as shown in FIGS. 6, 6A, 7, 7A, 8 and 8A downloaded from the cable TV head end via a two-way communications link linking the remote control device and cable converter. As will be evident from the block diagrams representing the cable converter 6 and universal remote control device 5, messages relayed to the set top converter 6 from the head end cable facility *may be downloaded to the remote control device for display.*

(Emphasis added.) From the above passage, it is clear that, contrary to the Examiner's assertions, the displayed advertisement information as shown in Fig. 6A of Goldstein is not the same as "supplemental information **about** a broadcast" as claimed. Rather, such advertisement information, which includes isolated segments dispersed in a broadcast and which may optionally be downloaded, is not "about" the broadcast, nor is it associated with the broadcast.

For at least these reasons, Appellant respectfully submits that Goldstein does not teach each of the elements recited in Claims 78, 92, and 117. For at least these reasons, Appellant respectfully submits that the rejection of Claims 78, 92, and 117 under 35 U. S. C. § 103(a) is improper and should be reversed. For at least the same reasons, Appellant submits that the rejection of Claims 79-82, which depend from Claim 78, Claims 93, 95, 96, 102-104, and 106-110, which depend from Claim 92, and Claims 118-122, 124-130, 133-137, 160, and 161, which depend from Claim 117, is improper and should be reversed.

(iii) The combination of Palmer, Kiefl, and Goldstein teaches away from the claimed invention

A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). For the reasons described below, Appellant submits that Kiefl teaches away from the claimed invention.

Kiefl is directed toward a “system for monitoring and collecting data on the viewing habits of television viewers or radio listeners ....” (Abstract). Data is collected through “a portable personal data collection device, for use in monitoring audience attention to receivers for receiving broadcast stations ....” (Col. 2, lines 36-39). Kiefl discloses that the data collection device includes “a clock for providing a signal representing time, a memory for storing data ... and a processor means ....” (Col. 2, lines 42-46). The processing means is “responsive to said signal representing the time and to said station identifier for storing in said memory data comprising the time at the beginning and end of receiving signals from said particular one of said broadcast stations ....” (Col. 2, lines 47-51). Kiefl further discloses that “to avoid recording times for each channel selected when a viewer is scanning through a number of channels, it is desirable not to provide a record of channels selected for less than a preset short time, say for example, five seconds or less.” (Col. 6, lines 38-51).

As recited in the above-quoted passage of Kiefl, the system of Kiefl *excludes short time periods such as those less than five seconds*. Thus, Kiefl clearly teaches away from the claimed invention. This is evident from, for example, the fact that it may take less than five seconds to make a request, and for the time-of-day information corresponding to a time at which the request is received to be stored. Employing the system of Kiefl in an attempt to arrive at the claimed invention would cause many of the “requests,” and subsequently the “supplemental information,” to be lost. As such, the proposed combination teaches away from Appellant’s claimed invention.

For at least these reasons, Appellant respectfully submits that Palmer, Kiefl, and Goldstein do not teach each of the limitations recited in Claims 78, 92, and 117. For at least these reasons, Appellant respectfully submits that the rejection of Claims 78, 92, and 117 under 35 U. S. C. § 103(a) is improper and should be reversed. For at least the same reasons, Appellant submits that the rejection of Claims 79-82, which depend from Claim 78,

Claims 93, 95, 96, 102-104, and 106-110, which depend from Claim 92, and Claims 118-122, 124-130, 133-137, 160, and 161, which depend from Claim 117, is improper and should be reversed.

- (iv) The combination of Palmer, Kiefl, and Goldstein renders the prior art unsatisfactory for its intended purpose

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 (Fed. Cir. 1984). Appellant submits that the combination of Palmer, Kiefl, and Goldstein would render Kiefl unsatisfactory for its intended purpose.

As described above, Kiefl discloses that “to avoid recording times for each channel selected when a viewer is scanning through a number of channels, it is desirable not to provide a record of channels selected for less than a preset short time, say for example, five seconds or less.” (Col. 6, lines 38-51). As further described above, this provision of Kiefl teaches away from the claimed invention. As such, to arrive at the claimed invention, this provision would have to be removed from Kiefl, in addition to the other deficiencies described above. However, removing the provision in Kiefl of *not providing a record of channels selected for less than a preset short time* would render Kiefl inoperable. The resulting system would be constantly recording times for each channel selected even when a viewer is scanning through a number of channels. This would defeat the purpose of Kiefl, that is, to monitor audience *attention* to receivers for receiving broadcast signals (e.g., col. 2, lines 36-39).

For at least these reasons, Appellant respectfully submits that the proposed combination of Palmer, Kiefl, and Goldstein renders Kiefl unsatisfactory for its intended purpose, and that there is no motivation or suggestion to combine the references. Appellant respectfully submits that the rejection of Claims 78, 92, and 117 under 35 U. S. C. § 103(a) is improper

and should be reversed. For at least the same reasons, Appellant submits that the rejection of Claims 79-82, which depend from Claim 78, Claims 93, 95, 96, 102-104, and 106-110, which depend from Claim 92, and Claims 118-122, 124-130, 133-137, 160, and 161, which depend from Claim 117, is improper and should be reversed.

(v) Claim 95

Claim 95 recites that “the memory is removable from the device **for transport to a different location for communicating the time-of-day information to the database.**” (Emphasis added). On page 12 of the Final Office Action, the Examiner acknowledged that the combination of Palmer, Kiefl, and Goldstein fails to teach such elements. On pages 12-13 of the Final Office Action, the Examiner took “official notice that the use of removable memory devices is notoriously well known in the art.” To support the official notice, the Examiner relied on col. 7, lines 36-49 of United States Patent No. 5,724,521 to Dedrick (hereinafter “Dedrick”). (Page 3 of the Final Office Action). At col. 7, lines 36-49, Dedrick states that:

In one embodiment, the information in personal profile database 27 is protected from access by anyone other than the individual who is associated with the information. For example, the information may be protected on a computer by encrypting the profile when it is not in use. Alternatively, the information may be stored on a removable nonvolatile storage device, such as a PCMCIA Flash memory card. Thus, an individual may remove the Flash-based profile card from a computer and thereby remove the risk of exposure of private information to other individuals operating in the network system 10. In addition, since the profile is removable, individual end users can move a profile from computer to computer, such as between office and home.

Thus, Dedrick discloses that a flash memory card can be removed from a computer to reduce the risk of exposing personal information and for moving a profile from computer to computer. However, Dedrick fails to teach, suggest, or describe that the “memory is removable from the device **for transport to a different location for communicating the time-of-day information to the database,**” as recited in Claim 95.



(Emphasis added). For at least these reasons, Appellant submits that the rejection of Claim 95 is improper and should be withdrawn.

(vi). Claim 103

Claim 103 recites that “the controller is configured to ... store identification information in the memory” and “communicate the identification information to the database along with the request.” (Emphasis added). On pages 13-14 of the Final Office Action, the Examiner asserted that Palmer discloses such elements at col. 4, lines 10-37, specifically col. 4, lines 31-37. Appellant disagrees. At col. 4, lines 31-37, Palmer states:

It is also possible to provide broadcasters and advertisers detailed data regarding geographical locations of users, which channels were watched and at what times. This information will be determined by analyzing data gathered at the time of each viewer response and stored in database 20.

Thus, Palmer discloses providing broadcasters/advertisers with data regarding geographical locations of viewers and channels watched. Appellant submits that providing geographical and channel data to broadcasters/advertisers is not the same as communicating “identification information to the database along with the request,” as recited in Claim 103. Palmer fails to teach, suggest, or describe such elements. Kiefl and Goldstein also fail to teach, suggest, or describe such elements. For at least these reasons, Appellant submits that the rejection of Claim 103 is improper and should be withdrawn.

(vii) Claims 104 and 161

Claim 104 recites “data processor means for analyzing the identification information to determine a number of requests for the supplemental information.” (Emphasis added). Claim 161 recites “wherein the database is configured to analyze the identification information to determine a number of requests for the supplemental information.” (Emphasis added). On pages 14 and 22 of the Final Office Action, the Examiner asserted that Palmer discloses such elements at col. 4, lines 31-37. Appellant disagrees.

As discussed above with reference to Claim 103, at col. 4, lines 31-37, Palmer discloses providing broadcasters/advertisers with data regarding geographical locations of viewers and channels watched. However, providing geographical and channel data to broadcasters/advertisers is not the same as **“analyzing the identification information to determine a number of requests for the supplemental information,”** as recited in Claim 104. (Emphasis added). Claim 161 includes similar elements. Palmer fails to teach, suggest, or describe such elements. Kiefl and Goldstein also fail to teach, suggest, or describe such elements. For at least these reasons, Appellant submits that the rejection of Claims 104 and 161 is improper and should be withdrawn.

(viii) Claims 107 and 134

Claim 107 recites “data processor means for **erasing the time-of-day information from the memory in response to a request from the database.**” (Emphasis added). Claim 134 recites “wherein the controller is further configured to **erase the time-of-day information from the memory in response to a request from the database.**” (Emphasis added). On pages 14 and 20 of the Final Office Action, the Examiner acknowledged that the combination of Palmer, Kiefl, and Goldstein fails to teach such elements. However, the Examiner took “official notice” on pages 14 and 20 of the Final Office Action “that means for erasing stored data from memory is notoriously well known in the art ....” To support the official notice, the Examiner relied on col. 26, lines 37-47 of United States Patent No. 5,860,136 to Fenner (hereinafter “Fenner”). At col. 26, lines 37-47, Fenner states:

To delete records, the host system presents a "DELETE RECORD" command on line 519. To perform the delete function, the key must be presented on input key bus 501. Learned key logic 88 then deletes any key index value that is being used only by the key associated with that record by writing a zero into the table entry with write index bus 520. Deleting any unused index values permits them to be reused for the un-encoded key symbols that may be subsequently presented, thereby providing more efficient use of the record

memory 78. The "deleted" record is simply overwritten with a new record when one is presented.

Thus, Fenner discloses a system which utilizes a delete record command to deleting records. However, Claim 107 recites "erasing the time-of-day information from the memory **in response to a request from the database.**" (Emphasis added). Claim 134 includes similar elements. Fenner fails to teach, suggest, or describe erasing time-of-day information in response to a request from the database. For at least these reasons, Appellant submits that the rejection of Claims 107 and 134 is improper and should be withdrawn.

(ix) Claims 109 and 136

Claim 109 recites "wherein the supplemental information **includes a copy of the broadcast** in an audio format, a video format, or a text format." (Emphasis added). Claim 136 recites "wherein the supplemental information **includes a copy of the broadcast.**" (Emphasis added). On pages 16 and 21 of the Final Office Action, the Examiner asserted that such elements are disclosed by Palmer at col. 3, lines 25-32. Appellants disagree. At col. 3, lines 25-32, Palmer states:

The database also includes unique program data associated with each PIC code, which includes information regarding the particular program identified by the PIC code, such as purchase receipts, details regarding the products and services advertised in the commercial, or any other information an advertiser wishes to convey to the viewer via a fax transmission.

Thus, at col. 3, lines 25-32, Palmer discloses a database that includes information regarding a particular program identified by a PIC code. Appellant submits that information *regarding* a particular program is not the same as "supplemental information" which "**includes a copy of the broadcast,**" as recited in Claims 109 and 136. Palmer fails to teach such elements. Kiefl and Goldstein also fail to teach such elements. For at least

these reasons, Appellant submits that the rejection of Claims 109 and 136 is improper and should be withdrawn.

### III. REJECTIONS OF CLAIMS 94, 105, 123, AND 132 UNDER 35 U. S. C. § 103(a)

(i) Claims 94, 105, 123, and 132

In section 4 of the Final Office Action, Claims 94, 105, 123, and 132 were rejected under 35 U. S. C. § 103(a) as being unpatentable over Palmer, Kiefl, and Goldstein, and further in view of Welsh. For the reasons given below, Appellant submits that the Examiner's rejection of Claims 94, 105, 123, and 132 is improper and should be reversed.

As discussed above, whether considered separately or in any combination, Palmer, Kiefl, and Goldstein fail to teach, suggest, or describe at least a controller configured to store "time-of-day information [which] corresponds to a time at which a request for the supplemental information is received," as recited in Claims 92 and 117.

Welsh is directed toward "a method and apparatus for automatic monitoring of broadcast band listening habits using an electronic monitor." (Col. 1, lines 44-46). The electronic monitor is configured for "electronically tuning a broadcast band tuner ... until a match is found with ... [an] acoustically sensed signal, and recording the time and frequency" of the match for monitoring the user. (Col. 1, lines 49-53). However, Welsh fails to teach or suggest a controller configured to store "time-of-day information [which] corresponds to a time at which a request for the supplemental information is received," as recited in Claims 92 and 117. (Emphasis added). Thus, Welsh fails to supply that which Palmer, Kiefl, and Goldstein lack.

For at least these reasons, Appellant respectfully submits that whether considered separately or in any combination, Palmer, Goldstein, Kiefl, and Welsh fail to teach or suggest all of the elements recited in Claims 92 and 117. Accordingly, Appellant

respectfully submits that Claims 92 and 117 are allowable in view of the combination of Palmer, Goldstein, Kiefl, and Welsh. For at least the same reasons, Appellant also submits that the rejection of Claims 94 and 105, which depend from Claim 92, and Claims 123 and 132, which depend from Claim 117, is improper and should be withdrawn.

(ii) Claim 94

Claim 94 recites that “the supplemental information is stored as a function of station identification information,” that “the device further includes a broadcast station tuner for deriving the station identification information,” and that “**the station identification information is communicated to the database along with the time-of-day information to identify the supplemental information** to be communicated to the device.” (Emphasis added). On page 22 of the Final Office Action, the Examiner acknowledged that the combination of Palmer, Kiefl, and Goldstein fails to teach such elements. On pages 22-23 of the Final Office Action, the Examiner stated that:

Welsh discloses a user-operable device which includes a broadcast station tuner for deriving station identification information (fig. 1, tuner circuit 16, col. 3, lines 60-66) which is reported back to a central database (col. 2, lines 3-23), for the benefit of automatic monitoring of broadcast content (the user is not required to input the station or time manually, col. 1, lines 44-59).

However, Claim 94 also recites that “the station identification information is communicated to the database along with the time-of-day information to identify the supplemental information.” (Emphasis added). Welsh fails to teach, suggest, or describe such elements. Palmer, Kiefl, and Goldstein also fail to teach such elements. For at least these reasons, Appellant submits that the rejection of Claim 94 is improper and should be withdrawn.

#### IV. REJECTIONS OF CLAIMS 97-101 UNDER 35 U. S. C. § 103(a)

In section 5 of the Final Office Action, Claims 97-101 were rejected under 35 U. S. C. § 103(a) as being unpatentable over Palmer, Kiefl, and Goldstein, and further in

view of Atcheson". For the reasons given below, Appellant submits that the Examiner's rejection of Claims 97-101 is improper and should be reversed.

As discussed above, whether considered separately or in any combination, Palmer, Kiefl, and Goldstein fail to teach, suggest, or describe at least a controller configured to store "time-of-day information [which] corresponds to a time at which a user request for the supplemental information is received," as recited in Claim 92. Atcheson is directed toward "a system for determining selections that a user is likely to be interested in." (Abstract). Atcheson does not teach or suggest a controller configured to store "time-of-day information [which] corresponds to a time at which a request for the supplemental information is received," as recited in Claim 92. (Emphasis added). Thus, Atcheson fails to supply that which Palmer, Kiefl, and Goldstein lack.

For at least these reasons, Appellant respectfully submits that whether considered separately or in any combination, Palmer, Goldstein, Kiefl, and Atcheson fail to teach or suggest all of the elements recited in Claim 92, and there is no motivation to combine these references. Accordingly, Appellant respectfully submits that Claim 92 is allowable in view of Palmer, Goldstein, Kiefl, and Atcheson. For at least the same reasons, Appellant also submits that the rejection of Claims 97-101, which depend from Claim 92, is improper and should be reversed.

**CONCLUSION**

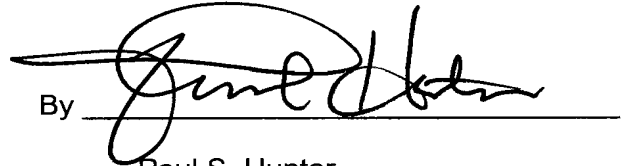
In view of the foregoing discussion and arguments, Appellant respectfully submits that Claims 78-82, 92-110, 117-130, 132-137, 160, and 161 are not properly rejected under 35 U. S. C. § 103(a) as being unpatentable over any combinations of Palmer, Goldstein, Kiefl, Welsh, and Atcheson. Accordingly, Appellant respectfully requests that the Board reverse all claim rejections and indicate that a Notice of Allowance respecting all pending claims should be issued.

Respectfully submitted,

Date September 15, 2008

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By

A handwritten signature in black ink, appearing to read "Paul S. Hunter", written over a horizontal line.

Paul S. Hunter  
Attorney for Appellant  
Registration No. 44,787

**CLAIMS APPENDIX**

1. – 77. (Canceled).

78. (Previously Presented) A method of providing supplemental information about a broadcast, the method comprising:

receiving, at a portable, hand-held electronic device, a request for supplemental information associated with the broadcast, wherein the hand-held electronic device includes a memory, a communications interface, and a clock;

storing, in the memory, time-of-day information corresponding to a time at which the request is received, wherein the time-of-day information is provided by the clock;

establishing a connection to a remote database through the communications interface;

transferring the time-of-day information stored in the memory to the remote database;

receiving the supplemental information, associated with the broadcast and identified through correlation of the time of day information to the broadcast, from the remote database; and

communicating the supplemental information using the hand-held electronic device.

79. (Previously Presented) The method of claim 78, wherein the broadcast comprises a radio program or a television program.

80. (Previously Presented) The method of claim 78, wherein the broadcast includes a musical selection.

81. (Previously Presented) The method of claim 78, wherein the broadcast includes an advertisement.

82. (Previously Presented) The method of claim 78, wherein the hand-held electronic device further includes a pushbutton control.



83. – 91. (Canceled)

92. (Previously Presented) A system for providing supplemental information about a broadcast, the system comprising:

a device located remotely from a database for storing supplemental information about a broadcast as a function of a time of day, the device including a memory, a communications interface, a clock, and a controller configured to:

(a) store time-of-day information from the clock in the memory, wherein the time-of-day information corresponds to a time at which a request for the supplemental information is received;

(b) establish a connection to the database through the communications interface; and

(c) communicate the time-of-day information stored in the memory to the database for identification of the supplemental information associated with the broadcast for communication of the supplemental information to the device.

93. (Previously Presented) The system of claim 92, wherein:  
the supplemental information is stored as a function of a date;  
the clock in the device outputs the date and the time-of-day information; and  
the date and the time-of-day information are communicated to the database to identify the supplemental information to be communicated to the device.

94. (Previously Presented) The system of claim 92, wherein:  
the supplemental information is stored as a function of station identification information;

the device further includes a broadcast station tuner for deriving the station identification information; and

the station identification information is communicated to the database along with the time-of-day information to identify the supplemental information to be communicated to the device.

95. (Previously Presented) The system of claim 92, wherein the memory is removable from the device for transport to a different location for communicating the time-of-day information to the database.

96. (Previously Presented) The system of claim 92, wherein the device forms part of a telephone.

97. (Previously Presented) The system of claim 92, wherein the supplemental information relates to at least one of a plurality of musical selections.

98. (Previously Presented) The system of claim 97, wherein:  
the device includes a display and means for playing a musical selection; and  
the controller is further configured to download the musical selection from the database to the device, play the musical selection, and display the supplemental information on the display.

99. (Previously Presented) The system of claim 98, wherein the supplemental information includes a name of the musical selection and an artist associated with the musical selection.

100. (Previously Presented) The system of claim 98, wherein the memory is configured to store the musical selection.

101. (Previously Presented) The system of claim 98, wherein the memory is configured to store the supplemental information.

102. (Previously Presented) The system of claim 92, wherein the communications interface is configured to wirelessly connect to a telephone network.

103. (Previously Presented) The system of claim 92, wherein the controller is configured to:

store identification information in the memory; and  
communicate the identification information to the database along with the  
request.

104. (Previously Presented) The system of claim 103, further including data processor means for analyzing the identification information to determine a number of requests for the supplemental information.

105. (Previously Presented) The system of claim 94, wherein the station identification information comprises station call letters.

106. (Previously Presented) The system of claim 92, wherein the device further includes a display, and wherein the controller is configured to provide the supplemental information through the display.

107. (Previously Presented) The system of claim 92, further including data processor means for erasing the time-of-day information from the memory in response to a request from the database.

108. (Previously Presented) The system of claim 92, wherein the controller is configured to correlate the clock in the device with a second clock in the database.

109. (Previously Presented) The system of claim 92, wherein the supplemental information includes a copy of the broadcast in an audio format, a video format, or a text format.

110. (Previously Presented) The system of claim 92, wherein the supplemental information includes a price of a product or a service, and an availability of the product or the service .

111. – 116. (Canceled).

117. (Previously Presented) A device for providing supplemental information associated with a broadcast, the device comprising:

a control, a memory, a communications interface, a clock, and a controller,  
wherein the controller is configured to:

store time-of-day information from the clock in the memory, wherein the time-of-day information corresponds to a time at which a request for the supplemental information is received through the control;

establish a connection to a database through the communications interface,  
wherein the database includes the supplemental information; and

communicate the time-of-day information stored in the memory to the database  
for identification of the supplemental information associated with the broadcast.

118. (Previously Presented) The device of claim 117, wherein the device is a hand-held, portable electronic device; and further wherein the control is a pushbutton.

119. (Previously Presented) The device of claim 117, wherein the broadcast comprises a radio program or a television program.

120. (Previously Presented) The device of claim 117, wherein the broadcast comprises an advertisement.

121. (Previously Presented) The device of claim 117, wherein the broadcast includes a musical selection, and further wherein the supplemental information is associated with the musical selection.

122. (Previously Presented) The device of claim 117, wherein the controller is further configured to communicate a date to the database along with the time-of-day information.

123. (Previously Presented) The device of claim 117, further comprising a station tuner, wherein the controller is configured to:

tune the device to a station to receive the broadcast;

obtain station identification information through the station tuner; and

communicate the station identification information to the database.

124. (Previously Presented) The device of claim 117, wherein the supplemental information is provided in print form.

125. (Previously Presented) The device of claim 117, wherein the established connection comprises a telephone connection.

126. (Previously Presented) The device of claim 125, wherein the supplemental information is provided through the telephone connection.

127. (Previously Presented) The device of claim 117, further comprising a display, wherein the supplemental information is provided through the display in a text format, an audio format, or a video format.

128. (Previously Presented) The device of claim 117, wherein the memory is configured to store the supplemental information.

129. (Previously Presented) The device of claim 117, wherein the connection comprises a wireless connection to a telephone network.

130. (Previously Presented) The device of claim 117, wherein the controller is further configured to communicate identification information to the database.

131. (Canceled).

132. (Previously Presented) The device of claim 123, wherein the station identification information comprises station call letters.

133. (Previously Presented) The device of claim 117, further comprising a display configured to display the supplemental information, wherein the display allows sorting and selection of the supplemental information.

134. (Previously Presented) The device of claim 117, wherein the controller is further configured to erase the time-of-day information from the memory in response to a request from the database.

135. (Previously Presented) The device of claim 117, wherein the controller is further configured to correlate the clock with a second clock associated with the database.

136. (Previously Presented) The device of claim 117, wherein the supplemental information includes a copy of the broadcast.

137. (Previously Presented) The device of claim 117, wherein the supplemental information includes a price of a product or a service.

138. – 159. (Canceled).

160. (Previously Presented) The device of claim 117, wherein the controller is further configured to receive identification information, store the identification information in the memory, and communicate the identification information to the database.

161. (Previously Presented) The device of claim 160, wherein the database is configured to analyze the identification information to determine a number of requests for the supplemental information.

162. – 165. (Canceled).

**EVIDENCE APPENDIX**

Appellant is not relying on any evidence submitted pursuant to 37 C.F.R. §§  
1.130, 1.131, or 1.132.

**RELATED PROCEEDINGS APPENDIX**

There are no related proceedings.